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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,757	04/16/2004	Jeffrey M. Linnen	GP146-04.UT	8545
21365 7590 02/05/2008 GEN PROBE INCORPORATED 10210 GENETIC CENTER DRIVE Mail Stop #1 / Patent Dept. SAN DIEGO, CA 92121			EXAMINER SALMON, KATHERINE D	
			ART UNIT 1634	PAPER NUMBER
			NOTIFICATION DATE 02/05/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/825,757	Applicant(s) LINNEN ET AL.	
	Examiner Katherine Salmon	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Page. (See 37 CFR 1.116 and 41.33(a)).

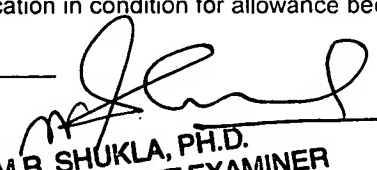
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 116-119, 124-130, 145-152 and 175-181.
Claim(s) withdrawn from consideration: 131-134, 139-144 and 153-174.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Page.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____


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Continuation of 3B: NOTE: The amendments to the claims are not being entered because the amendments to the claims raise new issues of new matter. The amendments to the claims raise issues of new matter because the amendments include length limitations of the base sequence which is not supported in the instant specification. Claim 175 require the new amendments of a base sequence of which "includes at least 18 contiguous bases of a base sequence selected from the group consisting of SEQ ID No: 24" and the new limitation of a sequence which "includes at least 18 contiguous bases of a base sequence selected from the group consisting of SEQ ID No. 25". These limitations consist of new matter because the instant specification does not provide support for the amendments.

The reply points to claims 169 as support for the amendments of Claim 175 (p. 9 4th paragraph). However, the length limitations in claim 169 are drawn to length limitations of SEQ ID No. 3 and not length limitations of nucleotides of the base sequences. Further, the reply points to the specification on p. 5 lines 3-8, and p. 19 lines 18-27 (p. 9 4th paragraph). The limitations found on p. 5 and p. 19 are drawn to length limitations of the probe length and not limitations of the number of contiguous bases of the base sequence.

These amendments to the claims, therefore, constitute new matter and will not be entered.

Continuation of 11: The reply does NOT place the application in condition for allowance because:

The reply traverses the rejection. The reply asserts that the rejection of the claims under 35 USC 112/second paragraph is moot based on amendments to the claims (p. 10 2nd paragraph). The amendments to the claims are not recited in the pending claims in view of the non-entry of the after final amendment. However the amendments to the claims if entered would overcome the 35 USC 112/2nd rejections.

The reply traverses the 35 USC 103(a) rejections. The response to arguments below is based on the limitations recited in the pending claims of 8/17/2007.

The reply asserts that the claims are drawn to probes having a target binding portion that consists of or is contained within and includes at least 18 contiguous bases of the base sequence of SEQ ID No. 3 and points to examples in the specification (p. 10 last paragraph). The amendments to the claims are not recited in the pending claims in view of the non-entry of the after final amendment and therefore this argument is directed to amendments which have not been entered.

The reply asserts arguments with regard to the 35 USC 103(a) rejection maintained in the final. The arguments as summarized below are considered based on the claims which were pending in the final rejection of the claims. The arguments based on the amended claims have not been considered because of the non-entry of the after final amendment. The reply asserts that as noted in example 1 probes having SEQ ID No. 44 and 45 did not detectably hybridize to the SARS-CoV amplicon even though there was an overlap of the nucleotides of SEQ ID No. 44 and 45 with the nucleotides of SEQ ID No. 3 (p. 11 1st paragraph). The applicant seems to be arguing that a probe consisting of SEQ ID No. 3 would have unexpected results compared to probes which only comprise fragments of the nucleotides of SEQ ID No. 3. However, the claims are not limited to probes which comprise SEQ ID No. 3, but rather, the probes claimed broadly encompass nucleotides which have at least one nucleotide in common, at least 10 nucleotides, at least 15 nucleotides, or at least 18 nucleotides in common. Therefore the applicant has not shown unexpected results with regard to the probes encompassed by the claims. As such, applicant has not provided evidence via secondary consideration that the probes made by the suggestion and teachings of the prior art would not be equivalent structures as the claimed probes. This should not be construed as an invitation for providing evidence. As further stated in the MPEP 716.01 regarding the timely submission of evidence:

A) Timeliness.

Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to a final rejection,
- (2) before appeal in an application not having a final rejection, or
- (3) after final rejection and submitted
 - (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or
 - (ii) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or
 - (iii) under 37 CFR 1.129(a).

The reply asserts that the amplification temperatures and the optimal regions for amplification have been added to the claims (p. 11 2nd paragraph). The amendments to the claims are not recited in the pending claims in view of the non-entry of the after final amendment and therefore the argument drawn to limitations added in the amendment have not been considered.

The reply asserts that the addition of McDonough et al. does not overcome the deficiencies of GenBank Accession No. NC_004718.1 and Peris et al. (p. 11 last paragraph). This has been fully reviewed but has not been found persuasive. The argument presented in the after final reply of unexpected results (p. 11 1st paragraph) is not sufficient to withdrawn the rejection because the claims are not limited to the unexpected results presented but rather to probes which broadly encompass any number of nucleotides of SEQ ID No. 3. Therefore the 35 USC 103(a) rejections are maintained.


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